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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,750	06/26/2001	Kevin Joseph Moriarty	QA0239ACIP	2728
7590	09/10/2004		EXAMINER	
Marla J. Mathias Bristol-Myers Squibb Company Patent Department P.O. Box 4000 Princeton, NJ 08543-4000			BALASUBRAMANIAN, VENKATARAMAN	
			ART UNIT	PAPER NUMBER
			1624	
			DATE MAILED: 09/10/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/891,750	MORIARTY ET AL.
	Examiner Venkataraman Balasubramanian	Art Unit 1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 June 2004.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 66,70-82,85,88 and 96-99 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 77 is/are allowed.  
 6) Claim(s) 66,70-76,78, 96 and 97 is/are rejected.  
 7) Claim(s) 79-82,85,88,98 and 99 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

Applicants' response filed on 6/18/2004, is made of record.

Claims 66, 70-82, 85, 88 and 96-99 are now pending.

In view of applicants' response, following apply.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 66, 70-76 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daeyaert et al US 6,150,360 for reasons of record. This rejection is same as made in the previous office action except that currently pending claims are included in the rejection. Applicants have not addressed this rejection in the amendment. This rejection is therefore maintained.

The following rejections made in the previous office action are maintained.

Claims 66, 70, 96 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitz et al. US 3,290,305.

Schmitz et al. teaches several trisubstituted triazines, which include compounds, claimed generically in the instant claims, for use as disinfectants.

See formula I on col. 2 and note the definition of X, Y and Z. See the first compound on col. 3.

Claims 66, 70, 96 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winter et al. US 3,867,383.

Winter et al. teaches several trisubstituted triazines, which include compounds, claimed generically in the instant claims, for use as cardiovascular agents.

See formula I on col. 1 and note the definition of Z and R". See examples 2, 3, 4,5 and 6 for compounds made.

Claims 66, 70 96 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newton et al. US 5,062,882.

Newton et al. teaches several trisubstituted triazines, which include compounds, claimed generically in the instant claims, for use as herbicides.

See formula I on col. 1 and note the definition of Z, Y, R<sup>1</sup> and R<sup>2</sup>. See examples 1-67 and Table I for compounds made.

While said compound of the above references doesn't anticipate the scope of instant claims they are very closely related, being positional isomers of compounds i.e. 3-substituent in the phenyl ring vs 4-substituent in the phenyl ring . However, positional

isomers are not deemed patentably distinct absent evidence of superior or unexpected properties. See *In re Crounse*, 150 USPQ 554; *In re Norris* 84 USPQ 458; *In re Finely* 81 USPQ 383 and 387; *Ex parte Engelhardt*, 208 USPQ 343; *Ex parte Henkel*, 130 USPQ 474, regarding positional isomers.

Applicants' traversal to overcome these rejections is not persuasive. Applicants argue that the utility taught in these references are not the same. But these positional isomers and case law indicates that one trained in the art would be motivated to make the positional isomers, in this case the meta isomer, for the utility taught in the reference. See *In re Norris* 84 USPQ 458.

Hence these rejections are maintained.

#### ***Allowable Subject Matter***

Claim 77 is allowed. Claims 79-82, 85, 88, 98 and 99 are objected as dependent on a rejected claim but would be allowable if rewritten and to include all of the limitations of the base claim and any intervening claims. Said claims would be allowable as prior art search in the related area did not teach or suggest the compound, composition and method of use embraced in these claims.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (571) 272-0674. If Applicants are unable to reach Mukund Shah within 24-hour period, they may contact James O. Wilson, Acting-SPE of art unit 1624 at 571-272-0661.

The fax phone number for the organization where this application or proceeding is assigned (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

*Venkataraman Balasubramanian*  
Venkataraman Balasubramanian

9/5/2004